



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER OF PATENTS AND TRADEMARKS
Washington, D.C. 20231
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/229,704	01/13/1999	FRANCIS R. WALDMAN	1298/OE751	5569

7590

10/11/2002

Joseph B Ryan
Ryan Mason & Lewis LLP
90 Forest Avenue
Locust Valley, NY 11560

EXAMINER

TRAN, THIEN D

ART UNIT

PAPER NUMBER

2665

DATE MAILED: 10/11/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/229,704

Applicant(s)

WALDMAN, FRANCIS R.

Examiner

Thien D Tran

Art Unit

2665

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-17 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 3-8 is/are allowed.
- 6) ☒ Claim(s) 1,2 and 9-17 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on ____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) ____.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). ____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) do not apply to the examination of this application as the application being examined was not (1) filed on or after November 29, 2000, or (2) voluntarily published under 35 U.S.C. 122(b). Therefore, this application is examined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

2. Claims 1, 2, 9-16 are rejected under 35 U.S.C. 102(e) as being participated by Choudhury et al (U.S Patent No 5,933,412).

Regarding claims 1, 9, Choudhury discloses a method for interconnecting a domain system 1 (calling party asynchronous transfer mode system) having a calling party host A and a domain system 2 (called party asynchronous transfer mode system) having a called party host C using other domain (an intermediate switching asynchronous transfer mode network) and a switch 1K (border node) associated with each asynchronous transfer mode system comprising (figure.2, col.6 lines 5-55):

routing a call from said calling party host to the called party host over the intermediate switching asynchronous transfer mode network based on an ATM domain addressing scheme (intermediate switching ATM network addressing scheme) that is recognized by switch 1k (border node) and independent of an addressing scheme of the asynchronous transfer mode systems (figure.2, col.3 lines 55-65).

Regarding claims 2, 15, 16, Choudhury discloses a method comprising:

Translating VPI/VCI from switch to switch, which can be translated from switch SW1k to an intermediate network then to SW21 (substituting at the border node of the calling party asynchronous transfer mode system in a called party address information element an intermediate switching asynchronous transfer mode network address of the border node of the called party asynchronous transfer mode system) for the asynchronous transfer mode system address of the called party host (col.5 lines 50-65); and

routing the call over the intermediate switching asynchronous transfer mode network from the switch 1k (border node) of the calling party asynchronous transfer mode system to the switch 21 (border node) of the called party asynchronous transfer mode system based on the intermediate switching asynchronous transfer mode network address in the called party address information element (figure.2).

Regarding claim 10, Choudhury discloses that switch border nodes are asynchronous transfer mode switches (figure.2).

Regarding claims 11, 13, Choudhury discloses that calling party asynchronous transfer mode system comprises a calling party host directly connected to calling party border node (col.6 lines 5-20).

Regarding claims 12, 14, Choudhury discloses a calling party asynchronous transfer mode system comprises:

- a calling party host; and

- at least one calling party non-border node connected between said calling party host and said calling party border node (figure.2).

Regarding claim 17, Choudhury discloses a method for interconnecting a domain system 1 (calling party asynchronous transfer mode system) having a calling party host A and a domain system 2 (called party asynchronous transfer mode system) having a called party host C using other domain (an intermediate switching asynchronous transfer mode network) and a switch 1K (border node) associated with each asynchronous transfer mode system comprising (figure.2, col.6 lines 5-55):

- routing a call from said calling party host to the called party host over the intermediate switching asynchronous transfer mode network based on an ATM domain addressing scheme (intermediate switching ATM network addressing scheme) that is recognized by switch 1k (border node) and independent of an addressing scheme of the asynchronous transfer mode systems (figure.2, col.3 lines 55-65);

- generating at the calling party host a message specifying the ATM system address of the called party host in a called party address information element;

substituting at the calling party border node in the called party address information element the intermediate switching ATM network address of the called party border node for the ATM system address of the called party host;

transmitting the call over the intermediate switching ATM network to the called party border node based on the intermediate switching ATM network address of the called party border node in the called party address information element;

generating at the called party border node a message specifying in the called party address information element the ATM system address of the called party host; and

routing the call to the called party host based on the asynchronous transfer system address of the called party host in the called party address information element.
See col.3 lines 55-65, figure 2 and figure 6.

Allowable Subject Matter

3. Claims 3-8 are allowed.

Response to Argument

4. Applicant's arguments filed on 08/07/2002 have been fully considered but they are not persuasive.

Regarding claim 1, Applicant argues that Choudhury does not disclose an intermediate switching ATM network addressing scheme that is recognized by border nodes and independent of an addressing scheme of an ATM system. However,

examiner disagrees with the argument because Choudhury discloses that based on the address of a destination party, such as end host 12, indicated in the connection setup signaling request, switch SW1 determines the next switch in the route (disclose an intermediate switching ATM network addressing scheme) and that is a border node in each subsequent peer group will determine the exact set of transit switches to route the connection through its peer group (recognized by border nodes and independent of an addressing scheme of an ATM system). See col.3 lines 55-65 and col.4 lines 10-15.

Regarding claim 9, Applicant argues that Choudhury does not disclose an addressing scheme used in various domains of network. Examiner can't find the limitation "addressing scheme used in various domains of network" in the claim 9. Therefore, the argument does not have any weight.

Regarding claims 15 and 16, Applicant argues that Choudhury does not disclose substituting at a border node an intermediate ATM switching address. However, Examiner disagrees with the argument because Choudhury discloses mapping of the destination address from node to node (substitution of address from node to node in looking table) through destination. See col.3 lines 55-65.

Conclusion

5. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within

Art Unit: 2665

TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

6. Any inquiry concerning this communication or earlier communication from the examiner should be directed to Thien Tran whose telephone number is (703) 308-4388. The examiner can normally be reached on Monday-Friday from 8:30AM to 5:00PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Huy Vu, can be reached on (703) 308-6602. Any inquiry of a general nature of relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 305-3900.

Thien Tran



ALPUS H. HSU
PRIMARY EXAMINER